

## REMARKS

The purpose of this Reply is to place the claims in better form for appeal to the Board of Patent Appeals and Interferences.

### Specification Objection

The Examiner has objected to the amendment to the first paragraph under 35 U.S.C. 132(a) as allegedly introducing new matter on the ground that the recitation of 10/757077 as incorporated by reference was not found in the original specification. The Applicants respectfully ask for reconsideration under 37 C.F.R. § 1.111.

According to *MPEP* § 608.01(p), a referencing application must include an identification of the referenced patent, application, or publication being incorporated by reference. Although reference to an attorney's docket number and filing date for an incorporated reference is desirable, any description in the specification reasonably identifying the subject matter contained in the incorporated reference will be sufficient to establish identity for that incorporated reference. *Ex parte Harvey*, 163 USPQ 572 (B.P.A.I. 1968); and *In re Fouche*, 439 F.2d 1237, 169 USPQ 429 (CCPA 1971). *MPEP* § 608.01(p) acknowledges this precedent by stating that "Guidelines for situations where applicant is permitted to fill in a number for Application No. \_\_\_\_\_ left blank in the application as filed can be found in *In re Fouche*, 439 F.2d 1237, 169 USPQ 429 (CCPA 1971)." Thus, any description reasonably describing the subject matter of an incorporated reference will establish its identity.

In *Ex parte Harvey*, the applicant wanted to amend the specification by introducing the serial number and filing date of two copending applications referred to in the specification merely as "copending applications." *Ex parte Harvey*, 163 USPQ at 573. The Examiner rejected this amendment as new matter under 35 U.S.C. 132(a) on the ground that the incorporated references were insufficiently identified. *Id.* The Board reversed, finding that "[t]he description of the subject matter of the two applications and their relation to the claimed subject left little doubt . . . of the identity of the applications." *Id.* The Board further indicated

that, although not required, unambiguous identification of an incorporated application such as citation to an attorney's docket number and application filing date was desirable. *Id.*

Likewise, in *In re Fouche*, the Federal Circuit held that identification of an incorporated reference need only be reasonably precise. *In re Fouche*, 439 F.2d at 1089. In this case, an applicant disclosed in a pending application that a claimed compound could be "prepared as described in Example I of our application No." *Id.* at 1087. The specification provided no other identification of the referenced application. *Id.* The Board affirmed an Examiner's new matter rejection when the applicant attempted to amend the specification to "my Application Serial No. 459,921 filed May 17, 1965," ruling that "our application No" did not uniquely identify the incorporated reference and the applicant could have used more precise language. *Id.* at 1089. However, the *Fouche* Court reversed, finding that an applicant should be allowed to incorporate the disclosure of a reference "so long as the reference application is sufficiently well identified to distinguish it from all others." *Id.* at 1088. The Court also affirmed the Board's ruling in *ex parte Harvey*, stating that sufficient identification of an incorporated reference does not necessarily require an attorney's docket number. *Id.*

Thus, an incorporated reference need only be reasonably identified to distinguish it from other references, and although not required, an attorney's docket number is considered unambiguous identification of the incorporated reference.

The original first paragraph of the present application was:

This application is a continuation-in-part of U.S. Application Serial No. \_\_\_\_\_ [Attorney Docket No. ALLE0014-103] filed January 14, 2004, which is a continuation-in-part of U.S. Application Serial No. 10/163,106 filed June 4, 2002, which is a continuation-in-part of U.S. Application Serial No. 09/910,346 filed July 20, 2001; which is a continuation-in-part U.S. Application Serial No. 09/620,840 filed July 21, 2000, the disclosures of which are incorporated herein by reference in their entirety.

The marked up version of the amended first paragraph of the present application is:

~~The disclosures of This application is a continuation-in-part of U.S. Application Serial No. 10/757,077 [Attorney Docket No. ALLE0014-103] filed January 14, 2004, which is a continuation-in-part of U.S. Application Serial No. 10/163,106 filed June 4, 2002, which is a continuation-in-part of U.S. Application Serial No. 09/910,346 filed July 20, 2001 and ; which is a continuation-in-part U.S. Patent No. 6,903,187 issued June 7, 2005 Application Serial No. 09/620,840 filed July 21, 2000, the disclosures of which are all incorporated herein by reference in their entirety.~~

The clean version of the amended first paragraph of the present application is:

The disclosures of U.S. Application Serial No. 10/757,077 filed January 14, 2004, U.S. Application Serial No. 10/163,106 filed June 4, 2002, U.S. Application Serial No. 09/910,346 filed July 20, 2001 and U.S. Patent No. 6,903,187 issued June 7, 2005 are all incorporated herein by reference in their entirety.

The Applicants respectfully submit that Attorney Docket No. ALLE0014-103 filed January 14, 2004 is U.S. Application Serial No. 10/757,077. The original disclosure indicates that the incorporated reference is a continuation-in-part application that was filed on January 14, 2004 under the attorney's docket No. ALLE0014-103. Thus, like *Ex parte Harvey* the mere fact that the description of the subject matter of the incorporated application and its relation to the claimed subject matter of the present specification leaves little doubt to the identity of the incorporated application. Furthermore, merely viewing patent application 10/757,077 in PAIR and examining the pdf file for the specification filed on January 14, 2004 reveals that the attorney's docket No. ALLE0014-103 is clearly present in the header on each page of the specification. For the Examiner's convenience, the Applicants have provided a copy of page 1 from U.S. Application Serial No. 10/757,077. See Appendix A. As indicated in both *Ex parte Harvey* and *In re Fouché*, reference to the incorporated application by both an attorney's docket number and its filing date is definite and unambiguous identification of the incorporated reference. As such, the evidence of record clearly establishes the patent

application referred to as "Attorney Docket No. ALLE0014-103 filed January 14, 2004" in the first paragraph of the present specification is U.S. Application Serial No. 10/757,077.

Therefore, the Applicants respectfully request withdrawal of the objection to the first paragraph amendment because the amended specification does not introduce new matter into the disclosure.

#### **Rejections Pursuant to 35 U.S.C. § 112, ¶ 1 Written Description**

The Applicants have filed a Notice of Appeal with the Board of Patent Appeals and Interferences from the last decision of the Examiner dated March 29, 2007 rejecting Claims 3, 4, 46 and 47 as allegedly lacking written description pursuant to 35 U.S.C. § 112, ¶ 1.

#### **Rejection Pursuant to 35 U.S.C. § 103(a) Obviousness**

The Applicants have filed a Notice of Appeal with the Board of Patent Appeals and Interferences from the last decision of the Examiner dated March 29, 2007 rejecting Claims 1, 3-20, 22, 45-47, 56 and 57 as allegedly being obvious pursuant to 35 U.S.C. § 103(a).

### CONCLUSION

For the above reasons the Applicants respectfully submit that the claims are in condition for allowance, and the Applicants respectfully urge the Examiner to issue a Notice to that effect. Should there be any questions, the Examiner is invited to call the undersigned agent.

Please use Deposit Account 01-0885 for the payment of any extension of time fees under 37 C.F.R. § 1.136 or any other fees due in connection with the current response.

Respectfully submitted,

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